

R E M A R K S

Claims 1, 16, 19, 20, 22-24, and 26 are amended. Claims 2-5 and 21 are canceled. Claims 6-15, 17, 18, 25, and 27 stand as originally filed. Re-examination and reconsideration are requested.

In the office action, paper number (unspecified), dated October 10, 2006, the examiner objected to claims 3 and 26 as containing certain typographical errors, as set forth in section 5 of the office action. The examiner objected to claims 3 and 4 as failing to further limit the subject matter of claim 2, as set forth in section 6 of the office action. The examiner rejected claims 1-19 under 35 U.S.C. §101 as being directed to non-statutory subject matter. With regard to the art-based rejections, the examiner rejected claims 1-24 under 35 U.S.C. §102(b) as being anticipated by Mohan, et al., U.S. Patent No. 6,154,817 ("Mohan"). The examiner rejected claims 25-27 under 35 U.S.C. § 103(a) as being obvious over Mohan in view of the publication of Tanenbaum, entitled "Structured Computer Organization" ("Tanenbaum").

Re the Claims:

Claim 1 is amended to include "vaulting at least portions of said first and second sets of media . . ." as indicated in the listing of the claims. Support for the amendments to claim 1 is contained throughout the specification as originally filed and more specifically at, for example, paragraph 19. No new matter is added.

Claim 16 is amended to correct certain matters of form and to include "moving the set of media. . ." as indicated in the listing of the claims. Support for the amendments to claim 16 is contained throughout the specification as originally filed and more specifically at, for example, paragraph 30. No new matter is added.

Claim 19 is amended to correct a typographical error.

Claim 20 is amended to include the limitations previously contained in claim 21 (now canceled). No new matter is added.

5 Claims 22-24 are amended to change their dependencies from canceled claim 21 to amended claim 20.

Claim 26 is amended to correct the typographical error noted by the examiner.

Re the Objections to Claims 3 and 26:

10 The examiner objected to claims 3 and 26 as containing certain typographical errors. In response, applicants have canceled claim 3 and have amended claim 26 to correct the typographical error. Accordingly, the objections are overcome.

Re the Objections to Claims 3 and 4:

15 The examiner objected to claims 3 and 4 as being of improper dependent form for the reasons noted in Section 6 of the office action. However, these objections are moot in light of the cancellation of claims 3 and 4.

Re the Rejections of Claims 1-19:

20 The examiner rejected claims 1-19 under 35 U.S.C. §101 as being directed to non-statutory subject matter for the reasons specified in Section 8 of the office action. In response, applicants have amended independent claims 1 and 16 to recite tangible acts. More specifically, claim 1 now recites the act of "vaulting at least portions of said first and second sets of
25 media according to said plurality of vaulting procedures." Claim 16 now recites "moving the set of media based on said media movement job." Consequently, applicants believe that independent claims 1 and 16 (and the claims depending therefrom) now define statutory subject matter and respectfully request the examiner

to remove the Section 101 rejections.

Legal Standard For Rejecting Claims
Under 35 U.S.C. §102 and 103

5 The standard for lack of novelty, that is, for
"anticipation," under 35 U.S.C. §102 is one of strict identity.
To anticipate a claim for a patent, a single prior source must
contain all its essential elements. Hybritech, Inc. v.
Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986).
Invalidity for anticipation requires that all of the elements and
10 limitations of the claims be found within a single prior art
reference. Scripps Clinic & Research Foundation v. Genentech,
Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional
language, preambles, and language in "whereby," "thereby," and
"adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v.
15 Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

 The test for obviousness under 35 U.S.C. § 103 is whether
the claimed invention would have been obvious to those skilled
in the art in light of the knowledge made available by the
reference or references. In re Donovan, 184 USPQ 414, 420, n.
20 3 (CCPA 1975). It requires consideration of the entirety of the
disclosures of the references. In re Rinehart, 189 USPQ 143, 146
(CCPA 1976). All limitations of the claims must be considered.
In re Boe, 184 USPQ 38, 40 (CCPA 1974). In making a
determination as to obviousness, the references must be read
25 without benefit of applicants' teachings. In re Meng, 181 USPQ
94, 97 (CCPA 1974). In addition, the propriety of a Section 103
rejection is to be determined by whether the reference teachings
appear to be sufficient for one of ordinary skill in the relevant
art having the references before him to make the proposed
30 substitution, combination, or other modifications. In re
Lintner, 173 USPQ 560, 562 (CCPA 1972).

 A basic mandate inherent in Section 103 is that a piecemeal
reconstruction of prior art patents shall not be the basis for
a holding of obviousness. It is impermissible within the

framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Kamm, 172 USPQ 298, 301-302 (CCPA 1972). Put somewhat differently, the fact that the inventions of the references and of the applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. In re Donovan, 184 USPQ 414, 420 (CCPA 1975).

A reference which teaches away from the applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of applicants' claims. See United States v. Adams, 148 USPQ 429 (1966).

Re the Section 102 Rejections:

The examiner rejected claims 1-24 under 35 U.S.C. §102(b) as being anticipated by Mohan. These rejections are improper in that Mohan fails to disclose certain limitations contained in all of the pending claims. Because Mohan does not disclose at least these limitations, Mohan cannot anticipate pending claims 1, 6-20, and 22-24.

Independent claim 1 recites a method that comprises "creating a plurality of vaulting policies" each of which has one or more cycles that specify "a time to execute the cycle." While the examiner asserts that col. 7, lines 24 and 25 of Mohan meet this limitation, the time referred to by Mohan is not "a time to execute the cycle" as defined by claim 1, but is rather a "retention period" for the save set of media pool being created. In the present invention, the time to execute the cycle is described in paragraphs 27-30 and refers the time the media is to be moved to the destination location.

For example, and with reference to Figure 3 and paragraph 30 of the present invention, the "time to execute the cycle" is

presented in column 306 of Figure 3 and is listed as day 0 for the first row. That is, the policy is configured to move media on the day it is written (day 0) to the device located at site 1. Seven days later (i.e., "a time to execute the cycle" of 7), a second cycle specifies the media should be moved to an onsite vault also located at site 1. Thirty days after the media is written (i.e., "a time to execute the cycle" of 30), the media is moved to an offsite vault located at site 2.

In contrast, the "retention period" of Mohan refers to the time the media is to be used to retain data before it becomes available for re-use as scratch media. See, for example, col. 3, lines 54-59, col. 4, lines 30-34, and col. 12, lines 57-64 of Mohan. Clearly, then Mohan's "retention period" is not the same as the "time to execute the cycle" of claim 1. Consequently, Mohan cannot anticipate claim 1.

Dependent claims 6-15 are at least allowable over Mohan because they depend from claim 1, which is allowable over Mohan.

* * *

Independent claim 16 is allowable over Mohan because Mohan fails to disclose a method that involves "creating a media movement job" that comprises "a time period to perform the media movement" as specified by claim 16. The time period to perform the media movement is discussed in paragraph 33 of the present application and may include a start time to start the media movement job and a due time to complete the media movement job.

In supporting his rejection of claim 16, the examiner refers to the disclosure of Mohan contained at col. 8, lines 25-48 (section 14 of the office action). However, the referenced line numbers say nothing about a time period, much less a time period that may be regarded as meeting the limitations of claim 16. While col. 8, lines 49-50 of Mohan do describe a time period, the time period described is the user-input date and time that the backup job will run. However, this is not the same as the "time

period to perform the media movement" as set forth in claim 16. Consequently, claim 16 is not anticipated by Mohan.

Claims 17-19 are allowable over Mohan at least because they depend from claim 16, which is allowable over Mohan.

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Independent claim 20 is not anticipated by Mohan because Mohan fails to disclose a system comprising a plurality of vaulting policies having one or more cycles that specify "a time to execute the cycle." As discussed above with respect to claim 10 1, the "time to execute the cycle" refers to the time at which certain cycles of the vaulting policy are to be performed. In contrast, the "retention period" of Mohan refers to the time the media is to be used to retain data before it becomes available for re-use as scratch media. See, for example, col. 3, lines 54-15 59, col. 4, lines 30-34, and col. 12, lines 57-64 of Mohan. Because Mohan's "retention period" is not the same as the "time to execute the cycle" of claim 20, Mohan cannot anticipate claim 20.

Dependent claims 22-24 are at least allowable over Mohan because they depend from claim 20, which is allowable over Mohan. 20

Re the Section 103 Rejections:

The examiner rejected claims 25-27 under 35 U.S.C. § 103(a) as being obvious over Mohan in view of Tanenbaum. These rejections are improper because, even if Mohan and Tanenbaum were 25 combined, the resulting combination still would fail to meet the limitation of claims 25-27. Consequently, claims 25-27 cannot be obvious over Mohan and Tanenbaum.

Independent claim 25 is directed to a machine-readable medium having a sequence of instructions stored thereon which, 30 when executed by a machine create a plurality of vaulting policies, each of which includes one or more cycles that specify "a time to execute the cycle." However, as discussed above for

independent claims 1 and 20, Mohan's "retention period" is not the same as the "time to execute the cycle."

5 In the present invention, the time to execute the cycle is described in paragraphs 27-30 and refers the time the media is to be moved to various destination locations. For example, and with reference to paragraph 30 of the present invention, the "time to execute the cycle" is presented in column 306 of Figure 3 and is listed as day 0 for the first row. That is, the policy is configured to move media on the day it is written (i.e., a
10 "time to execute the cycle" of 0) to the device located at site 1. Seven days afterwards, a second cycle (i.e., a "time to execute the cycle" of 7) specifies the media should be moved to an onsite vault also located at site 1. Thirty days after the media is written, it is moved to an offsite vault located at site
15 2 (i.e., a "time to execute the cycle" of 30).

In contrast, the "retention period" of Mohan refers to the time the media is to be used to retain data before it becomes available for re-use as scratch media. See, for example, col. 3, lines 54-59, col. 4, lines 30-34, and col. 12, lines 57-64 of
20 Mohan. Therefore, even if Mohan and Tanenbaum are combined, the resulting combination would not meet all of the limitations of independent claim 25. Consequently, independent claim 25 cannot be obvious over any combination of Mohan and Tanenbaum. Claims 26 and 27 are at least allowable over Mohan and Tanenbaum because
25 they depend from claim 25, which is allowable over Mohan and Tanenbaum.

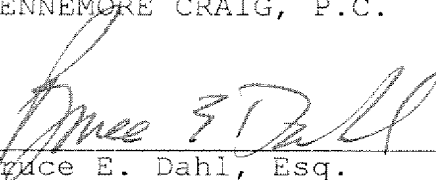
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30 Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the

applicants' attorney at the telephone number listed below.

Respectfully submitted,

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